

REMARKS

I. Status Summary

Claims 1-60 are pending in the present application. Claims 5-60 have been withdrawn pursuant to a Restriction/Election Requirement issued by the U.S. Patent Office (hereinafter "the Patent Office"). Claims 1-4 are currently under examination.

Claims 1-4 are rejected under 35 USC § 112, first paragraph, upon the contention that the claims fail to comply with the enablement requirement.

Claims 5-60 have been canceled. Claims 1, 2 and 3 have been amended. Support for the amendments to claims 1, 2 and 3 can be found throughout the specification as filed, including particularly in original claims 1, 2 and 3, and in the Sequence Listing. No new matter has been added.

Reconsideration of the application based on the amendments and arguments set forth herein is respectfully requested.

II. Summary of Telephone Conference with Examiner Shen

Applicants contacted Examiner Wu Cheng Winston Shen by telephone on December 1, 2008 to discuss the subject Advisory Action. The discussion was continued in a subsequent telephone conference on December 2, 2008. Participating in the discussions with Examiner Shen was applicants' agent of record, Leon R. Legleiter. Applicants sincerely appreciate Examiner Shen's time and consideration in agreeing to and participating in the discussion of the subject Advisory Action and patent application.

During the discussions with Examiner Shen, the outstanding rejections of Claims 1-4 under 35 U.S.C. § 112, first paragraph, were discussed. Applicants reached an agreement with Examiner Shen that Claims 1-4 as presently amended were in condition for allowance. Applicants respectfully submit that that the Amendments and Remarks presented herein are believed to be consistent with their understanding of Examiner Shen's position as presented during the telephone conferences on December 1 and December 2, 2008.

III. Response to the Rejection under 35 U.S.C. § 112, First Paragraph

In the subject Advisory Action the rejection of claims 1-4 under 35 USC § 112, first paragraph, upon the contention that the claims fail to comply with the enablement requirement, has been maintained for reasons of record.

After careful consideration of the rejections and the Patent Office's bases therefor, applicants respectfully traverse the rejections and submit the following remarks.

Without acquiescing to the contentions of the Patent Office and in an effort to further prosecution, applicants respectfully submit that claims 1, 2 and 3 have been amended. In particular, claim 1 has been amended to recite, "An isolated and purified biologically active heparan sulfate 3-O-sulfotransferase 5 polypeptide having the amino acid sequence set forth in SEQ ID NO 2." Claim 2 has been amended to recite "The isolated and purified biologically active heparan sulfate 3-O-sulfotransferase 5 polypeptide of claim 1, wherein the polypeptide comprises the polypeptide encoded by the nucleic acid sequence as set forth in SEQ ID NO 1." Finally, claim 3 has been amended to recite, "The polypeptide of claim 1, wherein the polypeptide is the human heparan sulfate 3-O-sulfotransferase 5 polypeptide." Support for the amendments to claims 1, 2 and 3 can be found throughout the specification as filed, including particularly in original claims 1, 2 and 3, and in the Sequence Listing. No new matter has been added.

Applicants respectfully submit that the specification adequately enables one of ordinary skill in the art to practice the claimed subject matter commensurate in scope with present claims 1, 2 and 3. Accordingly, applicants respectfully submit that present claims 1, 2 and 3 are believed to be in compliance with the enablement requirement under 35 USC § 112, first paragraph.

Claim 4 depends from claim 1 and is therefore also believed to be in compliance with the enablement requirement under 35 USC § 112, first paragraph, for at least the reasons discussed hereinabove.

Therefore, applicants respectfully submit that the instant rejection of claims 1-4 under 35 USC § 112, first paragraph, is believed to have been addressed. Withdrawal of the instant rejection is respectfully requested. A Notice of Allowance is also respectfully requested.

CONCLUSION

In light of the above amendments and remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Official Action.

DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any deficiencies of payment or credit any overpayment associated with the filing of this correspondence to Deposit Account No. 50-0426.

Respectfully submitted,

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